

REMARKS

This response is submitted in reply to the Office Action mailed on April 16, 2003. Claims 1-7, 9-12 and 14-35 are pending in this application. Claims 15-25 are allowed. New Claims 36 to 53 were added and claims 10 and 32 have been canceled without prejudice. Claims 1, 3, 4, 9 and 26 were rejected under 35 U.S.C. § 102(b); claims 2, 5, 6, 7, 11, 12, 14, 27-31, 33 and 35 were rejected under 35 U.S.C. § 103(a); and Claims 10, 32 and 34 were objected to as being dependent upon a rejected base claim.

As a preliminary matter, Claims 10 and 32 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicants added new claim 36 which includes the elements of independent claim 1 and objected dependent claim 10. Therefore, new independent claim 36 as well as new claims 37-44, which depend from new claim 36, are believed to be in condition for allowance. Similarly, Applicants added new claim 45, which includes the elements of independent claim 26 and objected dependent claim 32. Therefore, Applicants believe that new claim 32 as well as new claims 46-53, which depend from new claim 32, are now in condition for allowance.

Claims 1, 3, 4 and 9 and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application No. 2002/0078559A1 to Buchwalter et al. ("*Buchwalter*").

Section 35 U.S.C. § 102(b) states that a person shall be entitled to a patent unless the invention of the patent was "patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . ." (emphasis added). *Buchwalter* was filed on December 27, 2000 and published on June 27, 2002. The present patent application was filed on December 14, 2001. Because *Buchwalter* was not patented or published more than one year before the filing date of the present application, *Buchwalter* does not qualify as prior art under § 102(b). Thus, *Buchwalter* only qualifies as prior art under 35 U.S.C. § 102(e).

Even if claims 1, 3, 4 and 9 and 26 were rejected under 35 U.S.C. § 102(e), *Buchwalter* is not a proper prior art reference under § 102(e). Applicants have submitted herewith an English translation of the certified foreign priority document No. P2000-380944 Japanese Document, which Applicants filed on December 14, 2001, and a statement that the translation of the certified

copy of the document is accurate. The above documents perfect Applicants' claim for priority in accordance with MPEP 706.02(b). Therefore, Applicants respectfully submit that *Buchwalter* is not a proper prior art reference with respect to the claimed invention under § 102(e) because the earliest effective filing date of the present application, which is the foreign priority date of December 14, 2000, is earlier than the earliest effective U.S. filing date of *Buchwalter*, which is December 27, 2000. For these reasons, Applicants respectfully request that the rejection under § 102(b) based on *Buchwalter* be withdrawn.

Claims 2, 5, 6 and 7, 27-31 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buchwalter* in view of U.S. Patent No. 6,420,242 B1 to Cheung et al. ("*Cheung*"). As described above, *Buchwalter* is not a proper prior art reference based on its filing date with respect to the filing date of the present application. Moreover, *Cheung* does not disclose or suggest all of the elements of the claimed invention.

Cheung discloses a method of separating thin films from transparent growth substrates by selective optical processing. *Cheung* does not disclose or suggest selectively irradiating an interface between a first substrate and a device with an energy beam and transmitting the energy beam through the first substrate to selectively release the device from the substrate as in the claimed invention. Moreover, *Cheung* does not disclose or suggest "transferring the released device onto a device holding layer included on a device holding substrate" and then "transferring the device from the device holding layer onto a second substrate" as described in claims 1 and 26. Therefore, Applicants respectfully submit that claims 2, 5, 6 and 7, which depend from claim 1, and claims 27-31 and 33, which depend from claim 26, are allowable for at least the reasons set forth above with respect to independent claims 1 and 26, and for the further reasons that *Buchwalter* is not a proper prior art reference and *Cheung* does not disclose or suggest all of the elements of these claims. Thus, Applicants respectfully submit that claims 2, 5, 6 and 7, 27-31 and 33 are patentable over the art of record.

Claims 11, 12, 14 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buchwalter* in view of U.S. Patent No. 5,929,962 to Chiu et al. ("*Chiu*") and in further view of U.S. Patent No. 4,451,634 to Hatanaka et al. ("*Hatanaka*"). Applicants submit that the combination of *Buchwalter*, *Chiu* and *Hatanaka* does not teach or suggest all of the elements of Claims 11, 12, 14 and 35.

Buchwalter is not a proper prior art reference as described above. Furthermore, the combination of *Chiu* in view of *Hatanaka* does not disclose or suggest all of the elements of Claims 11, 12, 14 and 35. Specifically, For all these reasons, Applicants submit that Claims 11, 12, 14 and 35 are patentable over the art of record.

In light of the above, Applicants respectfully submit that Claims 1-7, 9, 11, 12, 14, 26-31, 33, 35-53 are novel and nonobvious over the art of record because the cited references, either alone or in combination, do not disclose, teach or suggest the claimed invention. Accordingly, Applicants respectfully request that claims 1-7, 9, 11, 12, 14, 26-31, 33, 35-53, as well as allowed claims 15-25, be deemed allowable at this time and that a timely notice of allowance be issued in this case.

Applicants are submitting this response as part of a Request for Continued Examination (R.C.E.) and acknowledge that a one-month extension of time is due in connection with this response. In addition, several new claims have been added to patent application. Therefore, a check in the amount of \$1346.00 is enclosed herewith for such fees. If any other fees are due in connection with this application as a whole, the office is authorized to deduct said fees form Deposit Account 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. (112857-306) on the account statement.

Respectfully submitted,



Christopher S. Hermanson (Reg. No. 48,244)
Bell, Boyd & Lloyd LLC
P.O. Box 1135
Chicago, Illinois 60690-1135
(312) 807-4225
Attorney for Applicant

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